

REMARKS

Before amendment, claims 1-24 were pending. In an office action dated September 20, 2006 and reiterated in an advisory action dated November 28, 2006, the Examiner rejected all claims. In the advisory action, the Examiner declined to enter proposed amendments. A series of telephone exchanges and some telephone interviews ensued.

Interview Efforts

On December 4 and 5, 2006, messages were exchanged with Examiner Stevens regarding non-entry of amendments that accompanied the response filed November 20, 2006. These exchanges led to a telephonic interview.

On or about December 11, 2006, a telephone interview was conducted with Examiner Stevens to raise the issue of refusal to enter amendments that would place the case in better condition for appeal. Because the amendments would eliminate issues under section 101 and 112 without narrowing or appreciably changing the scope of the claims, it was Applicants' position that the amendments should be entered. No agreement was reached. Applicants and Examiner concurred that the next step would be to raise the issue with Primary Examiner Alam.

Sometime in December, a conversation was had with Examiner Alam or voice mails were exchanged in which he proposed, at least for claim 1, that the limitations of claims 2 and 4 be incorporated into claim 1. This proposal was not discussed with Examiner Alam because he left for holiday before we could talk.

At about the expected time of Examiner Alam's return in January, Applicants contacted Examiner Stevens. A three-way telephonic interview was scheduled for January 26, 2007. Before the interview took place, on or about January 22, Examiner Alam called and the substance of claim 1 was discussed. No art references were discussed. Applicants' objection to incorporating the limitations of claim 4 into claim 1 was noted and understood. A draft amended claim 1 was prepared on January 23 and subsequently submitted by e-mail to Examiner Alam on January 31. The draft claim submitted was as shown in the appendix. Examiner Stevens was notified by telephone, so that the scheduled telephone conference could be cancelled.

On or about February 11, Examiner Stevens left a message responding to the claim submitted on January 31. He reported that Examiner Alam essentially wanted the limitations of claim 3 rolled into claim 1. In addition, claims 16-end should be cancelled, on the basis that they would otherwise be subject to a restriction requirement. We probably briefly talked about this.

Applicants submitted a proposed Examiner's amendment consistent with the message on the same day. (Due to foibles of fax transmission, Examiner Stevens' receipt may have been delayed by a week.) The proposed amendment was very similar to the agreed wording that is reflected in this amendment and RCE, but it referred to the structured documents as compliant with any version of various standards. It proposed that the Examiner restrict claims 16-24 and authorize cancellation following restriction.

On or about February 26th, we left a message for Examiner Stevens reminding him that March 20th would be the six month date for this case. Various scheduling calls ensued with Examiners Stevens and Alam, until an interview on March 20th at 7:00 am PDT was arranged.

Agreement Reached

Our three-way telephone conference took place as scheduled, enhanced by use of WebEx, so that the wording being negotiated could be seen by all participants. Use of WebEx was very helpful. No art references were discussed. The wording of claims 1-15 was discussed and refined as submitted above.

We discussed how claim 1, for instance, includes input of data via a graphical user interface, transformation of that data into a format suitable for a search engine that recognizes document fields, and output of data to a search engine, which typically resides on a server such as one of Google's search engine servers. The input-transformation-output discussion addressed any section 101 issues that might be raised during QAS review.

We agreed to report that a tentative agreement was reached for allowance of the claims as amended herein, subject to a further update search by Examiner Stevens.

Restrictability

Applicants would appreciate it if the Examiners would confirm their view that claims 16-24 were restrictable and that the basis for cancellation of those claims was tantamount to an actual restriction requirement.

Comment on Amendments

Amendment of claims 1, 8 and 15 should not narrow the scope of the claims, as the amendments primarily involve changing “one or more” to “at least one”, which does not change the claim scope. This is a useful wording change, because the subject changes from plural to singular, which reads better in subsequent references within the claim. Changing “fields” to “field” etc. does not narrow the claim. If anything, it broadens the claim. Changing “respective” to “a selected” more likely broadens than narrows the claim, because it requires only one context sensitive value specification. The change, “sending search criteria to a search engine that searches” makes it clear that the claim reads on a method that stops short of performing an actual search. This effectively broadens the claim, which previously referred to searching.

The independent claims are narrowed by requiring that the self-describing, structured documents be XML documents, rather than using XML documents as an example of self-describing, structure documents, as was the case in the original claims 3-4, for example.

Additional claims were amended by deleting the words “any version of” a standard. In general, deleting words from a claim is not considered to narrow the claim. In this instance, Applicants understand that the available protection for methods that conform to future extensions of current standards is provided by the doctrine of equivalents, rather than by literal infringement of a claim. The PTO objects to claiming compliance with future versions of a standard because one cannot yet say exactly how the future versions will read. Accordingly, the amended words do not narrow the claims and agreeably leave for doctrine of equivalents protection use of XML documents that comply with versions of the XML standards that had not been adopted when this application was filed.

We point out that none of the amendments respond to prior art references.

CONCLUSION

Applicant respectfully submits that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicant would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge any additional fees associated with this communication, or to credit any overpayment, to Deposit Account No. 50-0869 (Attorney Docket No. OIN 1009-1).

Respectfully submitted,

Dated: March 20, 2007

/Ernest J. Beffel, Jr./

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Appendix – Claim Prepared on or About January 23, 2007

1. (Proposed further amendment) A computer-implemented method of specifying a search among a plurality of ~~self-describing, structured XML~~ documents, said documents including document fields, the method including:

providing a graphical user interface including

a document type selection filter;

at least one document field selection filter, context sensitive to a selected document type;

at least one value specification field, context sensitive to a selected document field; and

as non-displaying fields, one or more path specifications ~~corresponding to the~~ that particularly identifies selectable document fields and ~~to the selectable~~ value specification fields, ~~said path specification identifying at least one node to be tested against the completed value specification;~~

receiving ~~a~~ after user selection the selected document type a completed value specification and a ~~corresponding~~ path specification that particularly identifies the selected document field; and

sending search criteria to a search engine that searches the ~~self-describing, structured XML~~ documents based on the completed value specification and the ~~corresponding received~~ path specification, the subset including documents of the selected document type.